

1 The opinion in support of the decision being entered today
2 was *not* written for publication and
3 is *not* binding precedent of the Board.
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7 UNITED STATES PATENT AND TRADEMARK OFFICE
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10 BEFORE THE BOARD OF PATENT APPEALS
11 AND INTERFERENCES
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13

14 *Ex parte* RONALD P. SANSONE,
15 ROBERT A. CORDERY, and DONALD G. MACKAY
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18 Appeal No. 2007-0678
19 Application No. 09/818,792
20 Technology Center 3600
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23 Decided: March 27, 2007
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26 Before TERRY J. OWENS, ANITA PELLMAN GROSS, and
27 ROBERT E. NAPPI *Administrative Patent Judges*.
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29 NAPPI, *Administrative Patent Judge*.
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32 DECISION ON APPEAL
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34 This is a decision on appeal under 35 U.S.C. § 134 of the final
35 rejection of claims 1 through 35. For the reasons stated *infra* we will not
36 sustain the Examiner's rejection of these claims.
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INVENTION

The invention is directed to a method of notifying people that they will receive letters or packages prior to physical delivery. See page 3 of Appellants' specification. Claim 1 is representative of the invention and reproduced below:

1. A method that enables a recipient to inform a carrier of the manner in which the recipient wants some or all of their mail delivered, said method comprises the steps of:

depositing by a sender with the carrier mail containing the recipient's name and physical address and a sender's name and address;

capturing by the carrier the name and physical address of the recipient and the sender in the form of an image;

transmitting the image to a data center where the image is processed by translating the image consisting of text and graphics to selected alphanumerics;

translating by a data center the name and physical address of the recipient into an e-mail address;

notifying by the data center to the recipient of the expected delivery of the deposited mail and indicating the selected alphanumerics of the translated image;

notifying by the recipient to the data center of the manner in which the recipient wants some or all of their mail delivered;

notifying by the data center to the carrier of the manner in which the recipient wants the mail delivered; and

delivering mail by the carrier to the recipient in the manner specified by the recipient to the carrier.

REFERENCES

The references relied upon by the Examiner are:

Higgins	US 5,754,671	May 19, 1998
Smith (Smith '808)	US 2002/0042808 A1	Apr. 11, 2002 (effectively filed Sep. 29, 2000)
Smith (Smith '306)	US 2002/0095306 A1	Jul. 18, 2002 (effectively filed Sep. 29, 2000)

REJECTION AT ISSUE

Claims 1 through 35 stand rejected under 35 U.S.C. § 103 (a) as being unpatentable over Smith ('306 or '808) in view of Higgins. The Examiner's rejection is set forth on pages 3 through 6 of the Answer. Throughout the opinion we make reference to the Brief (filed May 10, 2006), and the Answer (mailed July 7, 2006) for the respective details thereof.

ISSUES

Appellants contend that the Examiner's rejection of independent claim 1 under 35 U.S.C. § 103 (a) is in error. Appellants argue on page 18 of the brief:

Appellants do not claim a method in which a sender printed personal ID code is added to each mailpiece, and the ID code is captured by the post. Appellants claim a method in which the carrier captures the name and physical address of the recipient and sender in the form of an image and the translation by a data center of the name and physical address of the recipient into an e-mail address.

The Examiner contends that the rejection is proper and states on page 6 of the Answer:

Smith et al. does include the essential method steps of capturing', transmitting', translating', and notifying to enable a recipient to inform a carrier of the manner in which the recipient wants some or all of their mail. Furthermore, the appellant never expressly claims a particular approach (e.g. using the user ID or not requiring the ID) to capture the mail piece to patentably distinguish from the prior art. Accordingly, the difference between the appellant's invention and Smith et al, would be obvious.

Thus, the contentions present us with two issues a) is the scope of claim 1 limited to using a particular ID code and if so b) does Smith teach or suggest the claimed ID code.

FINDINGS OF FACT

Smith ('306) teaches a mail tracing and tracking system. See abstract. A user of the system accesses a web page and is able to see mail or packages that are to be delivered to the user. The user can also obtain information about the mail or packages. See figure 3 and paragraph 0010. The system allows a user to see an image of the mail; the image may be created by scanning the mail by the Post Office. See figure 6 and paragraph 0038. Smith ('306) teaches that the additional information displayed to the user is supplied directly from the sender through machine readable code, pre-coded delivery labels, or electronic mailings. See paragraph 0040. The system makes use of a database which links user physical address, e-mail, and user ID. See paragraph 0049. The user ID is used by the system to identify the user and provides access to the system. See paragraph 0054. Smith ('306)

1 incorporates by reference the disclosure of Smith ('808). See paragraph
2 0020.

3 Smith ('808) discloses that the tracking system can be used to
4 perform selected actions with the mail such as change delivery method or
5 location. See paragraph 0015. Further, Smith ('808) teaches that the system
6 can use identifiers other than physical address of the user to determine the
7 identity of the individual to whom the letter or package is destined. Smith
8 ('808) discusses addressing physical letters using an identifier such as an e-
9 mail address; this address can then be correlated with the individual's
10 current physical address. See paragraph 0025. Further, Smith ('808)
11 teaches that the identifiers can be machine read from the letter, and the
12 current physical address is then printed on the letter for physical delivery.
13 See paragraphs 0026 and 0027. We find no discussion in Smith ('808) of
14 scanning in a physical address and translating it to an e-mail address.

15 Higgins teaches a system for recognition of an address on a letter
16 which has been hand written in cursive. See abstract. We find no
17 discussion in Higgins of scanning a physical address and translating it to an
18 e-mail address.

19 PRINCIPLES OF LAW

20 Office personnel must rely on Appellants' disclosure to properly
21 determine the meaning of the terms used in the claims. *Markman v.*
22 *Westview Instruments, Inc.*, 52 F3d 967, 980, 34 USPQ2d 1321, 1330 (Fed.
23 Cir. 1995). "[I]nterpreting what is *meant* by a word *in* a claim 'is not to be
24 confused with adding an extraneous limitation appearing in the
25 specification, which is improper.'" (emphasis original) *In re Cruciferous*

1 *Sprout Litigation*, 301 F.3d 1343, 1348, 64 USPQ2d 1202, 1205, (Fed. Cir.
2 2002) (citing *Intervet America Inc v. Kee-Vet Laboratories Inc.*, 12
3 USPQ2d 1474, 1476 (Fed. Cir. 1989

4 ANALYSIS

5 Independent claim 1, recites “capturing ... the name and physical
6 address of the recipient and the sender in the form of an image ... the image
7 is processed by translating the image consisting of text and graphics to
8 selected alphanumerics ... translating by a data center the name and
9 physical address of the recipient into an e-mail address.” Thus, we find the
10 scope of claim 1 includes that an image of the letter which contains a
11 physical address is captured, and the physical address is translated into an e-
12 mail address.

13 As discussed *supra*, we do not find that either of the Smith references
14 teaches translating a physical address to an e-mail address, nor do we find
15 that Higgins teaches this step.

16 CONCLUSION

17 We consider the Examiner’s rejection under 35 U.S.C. § 103 (a) to be
18 in error as we do not find that the combination of the references applied by
19 the Examiner teaches all of the limitations of independent claim 1.
20 Accordingly we will not sustain the Examiner’s rejection of independent
21 claim 1 or dependent claims 2 through 35 under 35 U.S.C. § 103 (a).

ORDER

For the forgoing reasons, we will not sustain the Examiner's rejections of claims 1 through 35, under 35 U.S.C. § 103. The decision of the Examiner is reversed.

REVERSED

vsh

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